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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,445	06/26/2003	Shuichi Sugita	2204-031174	2951

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,445	SUGITA ET AL.	
	Examiner	Art Unit	
	Kevin R. Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 17, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 17, 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The rejection of claims 1-9 under 35 U.S.C. 112, second paragraph has been overcome by amendment. Herein, "the same" will be understood to mean that the two measurements are exactly identical since the original disclosure does not support any other interpretation.

3. The rejection of claims 1-9 under 35 U.S.C.112, first paragraph as failing to comply with the enablement requirement has been overcome because the prior art recognizes said pigments are effective without the use of a pigmented base coat (see Panush-WO84/01909).

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear from applicant's response where the original disclosure contains support for the newly added limitation that the laminate is such that "the light reflected from the base metal sheet is the same as the light reflected from the base metal sheet having a clear paint film or clear paint film in combination with an under clear coat and/or top coat."

Claim Rejections - 35 USC § 102

Note: for purposes of examination, the term "flake" is understood to be a "flattened piece" as defined by Merriam Webster's Collegiate Dictionary.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 84/01909 (herein referred to as Panush).

Panush teaches a pearlescent coating composition comprising a resin binder system and coated-mica particles (abstract). The coated-mica particles are preferably flakes (page 13, lines 1+) and are coated with iron oxides (abstract). The coating composition is of particular value in two-coat automotive paint systems wherein the pearlescent composition is applied as the base coat to a metallic substrate (page 4, lines 4+) and a clear topcoat is then applied thereto. Said basecoat may be void of conventional pigments (page 3, lines 3+) and may be applied in a plurality of coating

passes (page 15). In such an embodiment, the bottom layer of said multi-layer pearlescent coating is understood to read on the claimed "under clear coat" and the upper pearlescent coating is understood to read on the claimed "clear-paint film." The coated mica is understood to read on the claimed "translucent flaky pigment" of claim 6. Furthermore, the metal oxide coating is understood to meet the "metal oxide" embodiment of claim 7.

The laminate is understood to be such that "the light reflected from the base metal sheet is the same as the light reflected from the base metal sheet having a clear paint film or clear paint film in combination with an under clear coat and/or top coat." The examiner takes said position because said laminate comprises the same compositionally identical layers as the claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 84/01909 (herein referred to as Panush), as applied to claims above, and further in view of Panush et al (US 4,547,410).

Panush also does not teach that the topcoat may comprise transparent or translucent inorganic flakes. However, Panush'410 teaches a multilayer coating finish

comprising translucent inorganic flakes applied to a metal substrate (col 3, lines 44+). The flakes comprise mica particles coated with metal oxide particles such as titanium dioxide, zirconium dioxide and iron oxide (incorporated by reference to US 4,407,969). Panush'410 teaches the topcoat may contain said coated mica flakes (col 4, lines 12+) in order to influence the appearance of the coating. Thus, it would have been obvious to add mica flakes to the topcoat of the finish taught in Panush. The motivation for doing so would have been that Panush'410 teaches said flakes may be added to topcoat compositions in order to make the topcoat more influential in the appearance of the coating.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 84/01909 (herein referred to as Panush) in view of Panush et al (US 4,547,410), as applied to claims above, and further in view of JP 62057676 (herein referred to as Kansai).

Panush is relied upon as above, but does not teach that the topcoat should comprise a matting agent. However, Kansai teaches a multi-layer coating comprising a pigmented basecoat and a topcoat comprising a matting agent. Preferred matting agents include silica and silicates with an average particle size of 4-6um (abstract). Using said matting agents in the topcoat results in a matted film (abstract). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a silica or silicate matting agents to the topcoat taught in Panush. The motivation for doing so would have been to give the resulting multi-layer coating a matted appearance.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 84/01909 (herein referred to as Panush), as applied to claims above, and further in view of Baumgart et al (US 6,534,185).

Panush is relied upon as above, but does not teach the claimed relative thickness of the clear coat. However, Baumgart teaches a clearcoat for an automobile finish (col 1, lines 5+) for use in two-coat systems (col 8, lines 7+). Baumgart teaches that the thickness of the clear coat would be varied in order to achieve the particular desired technical and visual effect (col 9, lines 5+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the thickness of the clearcoat taught in Pfenninger. The motivation for doing so would have been to obtain the desired technical and visual effects for the two-coat system.

The examiner notes that by varying the thickness of the clearcoat, one is inherently varying the ratio of the relative thickness of the clear coat to the pearlescent coat.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection. In order to expedite prosecution, the examiner will take this opportunity to respond to applicant's arguments that may be relevant to the newly applied claims.

Applicant makes reference to the "accompanying Declaration of the inventor." No such declaration has been filed. Therefore, the examiner is not able to respond applicant's arguments that refer to said declaration.

Applicant failed to address the outstanding 112, first paragraph rejection.

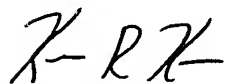
Therefore, the rejection is maintained.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,063,258 teaches a two coat system for use on metal substrates comprising an unpigmented pearlescent coating and a clear coat.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773